

### REMARKS

Claims 1-54 remain pending, of which claims 11, 13, 21-23, 42, 44 and 47 have been withdrawn. No amendment have been made herein. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Claims 1-10, 12, 14-20, 24-41, 43, 45, 46 and 48-54 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as their invention. In particular, the Office alleges that: "It is *unclear* what is meant by the 'shadowing structure.'" [Office Action, page 2, emphasis added]. Applicant respectfully traverses this rejection for *at least* the following reasons.

As a preliminary matter, Applicant notes that the Office provides no analysis, or other explanation, as to why the term "shadowing structure," is all allegedly unclear. This is improper. Indeed, MPEP § 2173.02 provides: "If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is 'vague and indefinite' should be included in the Office action." (emphasis added). Applicant thus, can only speculate as to what the examiner may have been thinking.

Notwithstanding this deficiency of the Office Action, Applicant submits that the claims are not indefinite. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). And, only if the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, might a rejection of the claim under 35 U.S.C. § 112, second paragraph, be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464,

1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. § 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. § 112, second paragraph, rather, the examiner should suggest improved language to the applicant. MPEP § 2173.02.

That being said, and quite contrary to the Office's remarks, Applicant submits that it should be clear to one skilled in the art what is meant by the term "shadowing structure" in the claims when read in light of the specification, including the plain language of the claims.

For example, the specification specifically refers to, and illustrates, an exemplary shadowing structure 4. [See, e.g., page 6, lines 13-19; page 7, lines 18-22; page 10, lines 14-18; Figures 1, 2, 39a.]. As such, Applicant submits that one skilled in the art having read the disclosure would be apprised as to what is meant by shadowing structure.

Moreover, the plain language of the claim is definite as to shadowing structure. Independent claim 1, for instance, recites:

... the surface structure of the plastic substrate being provided with a shadowing structure which is such that with the layer application process, parts of the shadowing structure are substantially not covered with the first conductive layer, the shadowing structure being such that the electrical resistance prevailing there is larger than the resistance in the rest of the first conductive layer.<sup>1</sup>

Thus, independent claims 1 and 31 explicitly recite *at least* (a) the location of the shadowing structure (i.e., provided on the surface structure of the plastic substrate); (b) that parts of the shadowing structure are not substantially covered with first conductive layer; and (c) the relative electrical resistance of the shadowing structure (i.e., the electrical resistance prevailing there is larger than the resistance in the rest of the first conductive layer). Applicant submits that independent claim 1 and 31 recite the structural and/or physical characteristics of the shadowing structure; thus, the metes and bounds of the claimed subject matter are set forth.

---

<sup>1</sup> Independent claim 31 includes similar recitations.

Further, dependent claims 10 and 34 *expressly* recite the construction of the shadowing structure. For instance, claim 10 recites:

[T]he shadowing structure comprises a number of parallel, narrow and deep grooves, the width and the depth of the grooves being such that at least a part of the side walls and/or the bottom of these grooves are substantially not covered with the first conductive layer in the sputtering process.

Thus, Applicant submits that the Office's assertion that it is unclear what is meant by the shadowing structure in the claims is without merit.

Accordingly, independent claims 1 and 31 are not indefinite under 35 U.S.C. § 112, second paragraph. Claims 1-10, 12, 14-20, 24-41, 43, 45, 46 and 48-54 ultimately depend from one of claim 1 and 31, and thus are also definite. Thus, the rejection of claims 1-10, 12, 14-20, 24-41, 43, 45, 46 and 48-54 under 35 U.S.C. § 112, second paragraph, should be withdrawn and the claims be allowed.

#### IMPROPER EXAMINATION PROCEDURE

Applicant notes that the Office further states that:

The lack of an art rejection with this Office action is not an indication of allowable subject matter. The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

[Office Action, page 3].

Applicant submits that this examination procedure is improper because it is inconsistent with the Office's compact prosecution guidelines and U.S. patent law. In fact, MPEP § 2106 provides that:

Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or

more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state *all* reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

[emphasis added].

And, MPEP § 707.07(g) specifically admonishes piecemeal examination. Applicant further submits that the Office's suggested *two-part* examination process for applying art to the claims after applicant has addressed the alleged indefiniteness is likewise improper. For instance, MPEP § 2143.03 provides:

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.).

[emphasis added].

Applicant therefore, submits that the Office should have substantively examined the claims in light of any relevant prior art, even having made the alleged rejection under § 112, second paragraph. Indeed, as discussed above, the claims specifically recite various features that could have been searched and examined, not to mention other features recited therein.

**CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

If an extension of time is necessary to prevent abandonment of this application, then such an extension of time is hereby petitioned for under 37 C.F.R. §1.136(a). Any fees required (including fees for net addition of claims) are hereby authorized to be charged to **Deposit Account No. 033975** (Ref. No. **008895-0316546**).

Date: **July 1, 2010**

Respectfully submitted,

By: 

Eric B. Compton  
Registration No. 54,806

**Customer No.: 00909**

Pillsbury Winthrop Shaw Pittman LLP  
P.O. Box 10500  
McLean, Virginia 22102

Direct: (703) 770-7721  
Main: (703) 770-7900  
Fax: (703) 770-7901